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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,167	12/15/2003	Yoshihiro Katsumata	Q78821	2113

23373 7590 07/24/2006

SUGHRUE MION, PLLC  
2100 PENNSYLVANIA AVENUE, N.W.  
SUITE 800  
WASHINGTON, DC 20037

EXAMINER

TRAN, THAO T

ART UNIT PAPER NUMBER

1711

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/734,167

Applicant(s)

KATSUMATA ET AL.

Examiner

Thao T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-22 and 24-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-22 and 24-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/28/2006 has been entered.
2. In this amendment, claims 17-22, 24-32 are pending in the application. No claims have been changed. Claims 31-32 have been newly added.

### ***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 17-21, 25-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haruta et al. (US Pat. 5,182,579) in view of Mochizuki et al. (US Pat. 5,477,963).

Haruta discloses an ink storing absorbent material for an ink jet made with a flexible polyurethane foam, where the foam is the reaction product of a polyol, an isocyanate, a catalyst, and a blowing agent (col. 1 lines 54-61). One embodiment shows foams having compression magnifications of 3 and cell numbers of 30-50 per inch (about 30-50 per 25 mm) (col. 15 lines 18-26). Since the ink storing material serves to provide ink to the printer head, the foam is also ink permeable. Haruta teaches a compressed foam with open cells for absorbing ink (col. 2 lines 33-45), also noting that the ink can comprise a surfactant (col. 35 lines 1-3). Thus, because the

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foam absorbs the ink, the foam would be impregnated with a surfactant when the ink comprises a surfactant. Also, since the foams contain a surfactant-containing fluid, it is the examiner's position that the foam would be indistinguishable from a foam made by the applicant's method of claim 21 and containing an ink. In such a case, the surfactant originally adhered to the foam surface would be dispersed in the ink fluid upon contact.

Although Haruta teaches an ink permeable absorbing member, the reference does not teach the inclusion of a second contacting foam having a specific compression magnification.

Mochizuki teaches an ink tank cartridge comprising a porous member having ink impregnated thereon (abstract). The porous member is compressed and may be provided in two or more layers; also, a separate second porous member is mentioned (col. 2 line 64-col. 3 line 11; col. 5 line 62-col. 6 line 4). Preferred porous members are formed of polyurethane foam (col. 5 lines 47-48).

When the porous member contains more than one layer, the pore sizes of the layers differ in that pore sizes closer to the port have smaller pores and thus are more absorbent (col. 9 line 56-col. 10 line 4; col. 9 lines 4-13). When three layers of porous member are used, the least concentrated layer could be considered an ink permeation layer, while the other two layers having increasing absorption and compression could be considered ink absorption layers. It is the examiner's position that it would have been prima facie obvious to adopt the layer structure/porous member plurality of Mochizuki's invention in the ink tanks of Haruta's invention to provide increasing ink flow to the printer head.

Regarding the amount of surfactant impregnated within the ink permeable member, Haruta teaches that additives, including surfactants, are employed in the ink compositions in

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amounts of 0.01-1% by weight. The ink compositions are impregnated into the foams in various amounts. It is the examiner's position that it would have been *prima facie* obvious to include the ink containing the surfactant in any amount necessary to provide sufficient ink for printing purposes. The concentration of surfactant impregnated in the foam would vary accordingly.

Regarding the compression magnification, it has been the examiner's position that it would have been obvious to use the structures/porous member pluralities of Mochizuki's invention ink tanks of Haruta's invention. These structures include a number of porous, absorbent layers having increasing compression magnification, where each of the layers is impregnated with ink. The absorbent member foams of the Haruta reference are taught to have various compression values, many of them above 5 (Tables 3-4). Thus, it would have been *prima facie* obvious to use those foams of higher compression for the high-compression layers in the multi-layered structure to optimize recording and ink mobility of the layers.

Inks used in the invention contain a coloring agent selected from water-soluble dyes or pigments (col. 35 lines 2-7).

5. Claims 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haruta et al. in view of Mochizuki et al. as applied to claims 17-21 and 25-26 above, and further in view of Konica Corp.

The references apply as above, teaching foams having ink stored therein but failing to teach denaturated sodium succinate surfactants within the inks. Konica Corp teaches inks for ink jet printers having dialkyl sulfosuccinate compounds added to the inks to provide improved interval properties (abstract). It is the examiner's position that it would have been *prima facie* obvious to add denaturated sodium succinate to the inks of the Haruta and Mochizuki invention

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in any amount necessary to optimize interval properties. Such optimization would provide foams having the claimed surfactant density.

***Response to Arguments***

6. Applicant's arguments filed on 4/28/2006 have been fully considered but they are not persuasive.

Applicants contend that Haruta differs from the presently claimed invention in that Haruta uses a surfactant for stability of the ink and adjustment of viscosity, whereas the presently claimed invention uses a different type of surfactant to enhance the affinity to ink. It is noted that the claim language does not include the type of surfactants to distinguish from the prior art. It is still the examiner's position that the Haruta reference teaches the impregnation of a surfactant by teaching that the foams are impregnated with ink, which contains a surfactant. Regarding the amount of surfactant, one skilled in the art would have chosen an amount of ink to optimize the printing properties of the cartridge and would have chosen an amount of surfactant as guided by the Haruta reference. Due to the broad ranges claimed by Applicants, it appears that the amounts of surfactant in the ink would fall within the claimed ranges.

Regarding Applicants' argument that Haruta does not teach the presence of a second contacting foam having a specific compression magnification, it is noted that the multi-layered structure of Mochizuki teaches the use of layers of increasing compression to increase capillary effect. Since the primary reference, Haruta, teaches various compressions for the foams, it would have been obvious to choose the foams of higher compression as the higher-compression layers. Thus, Mochizuki is used to remedy Haruta.

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7. In response to applicant's argument that there is no suggestion to combine the references of Haruta, Mochizuki, and Konica, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Konica is used to illustrate that denaturated sodium succinate surfactants has been taught in the prior art to provide improved interval properties of inks. Thus, Konica is used to remedy the Haruta combination.


#### ***Contact Information***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 9:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Thao T. Tran  
Primary Examiner  
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July 18, 2006